

### **REMARKS/ARGUMENTS**

In the Office Action mailed August 29, 2003, claims 1-24 were rejected. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references.

### **TELEPHONE INTERVIEW**

Applicants thank the Examiner for granting them a telephone interview on September 9, 2003. Applicants had asked the Examiner to clarify an aspect of claim 16, which the Examiner had used United States Patent No. 5,581,042 (hereinafter referred to as "Tambini") to reject this claim. The aspect of claim 16 was the positioning of the shaft between the tool and the fastener. The Examiner stated in the conversation with the Applicants that the Tambini reference did not disclose this aspect of the invention.

### **REQUEST FOR ENTRY OF AMENDMENT AFTER FINAL**

Applicants have amended claims 1, 9 and 12 to include the aspect of the invention recited in claim 16. This aspect is the "shaft configured to be positioned located between the tool and the fastener." Applicants respectfully submit that the amendment does not raise any new issue for consideration since it was previously presented in claim 16. The amendment also places the application in condition for allowance and better condition for appeal.

Applicants have further amended the claims to clarify the location of the angle indicator. The angle indicator is amended to state that it is apart from the tool. Entry of this amendment is

requested since it does not present any new matter and places the application in condition for allowance.

#### **CLAIM REJECTIONS – 35 U.S.C. § 103(a)**

The Examiner has used the Ermer reference (US2003/0040883) to support an obviousness rejection for claims 4, 5, 23 and 24. Applicants note that the Ermer reference qualifies for removal under 35 U.S.C. § 103(c) since it qualifies as prior art under 35 U.S.C. § 102(e). To further qualify under 35 U.S.C. § 103(c), the Ermer reference and the present invention must have common ownership at the time the present invention was made. Applicants hereby state that the Ermer reference and the present application, were, at the time the invention of the present application, owned by SPX Corporation. To aid the Examiner in analyzing this issue, Applicants have submitted the assignment for each invention. The assignment shows that both inventions were and are owned by SPX Corporation at the time the current invention was made. Applicants respectfully request withdrawal of the rejection of claims 4, 5, 23 and 24.

#### **CLAIM REJECTIONS – 35 U.S.C. § 103(a)**

The Examiner rejected claims 1-3 and 9-18 under 35 U.S.C. § 103(a) as being obvious over Tambini in view of United States Patent No. 4,589,289 to Neuhaus (hereinafter referred to as “Neuhaus”). Claims 4, 5, 23 and 24 are rejected under 35 U.S.C. § 103(a) as being obvious over Tambini in view of Neuhaus and in further view of Ermer. Claims 6 and 20 are rejected under 35 U.S.C. § 103(a) as being obvious over Tambini in view of Neuhaus and in further view of United States Patent No. 5,095,746 to Stanis (hereinafter referred to as “Stanis”). Claims 7

and 21 were rejected under 35 U.S.C. § 103(a) as being obvious over Tambini in view of Neuhaus and further in view of Stanis and United States Patent No. 4,308,779 to Suzuki (hereinafter referred to as “Suzuki”). Claims 8 and 22 were rejected under 35 U.S.C. § 103(a) as being obvious over Tambini in view of Neuhaus and in further view of United States Patent No. 5,571,971 to Chastel et al. (hereinafter referred to as “Chastel”). Claim 19 was rejected under 35 U.S.C. § 103(a) as being obvious over Tambini in view of Neuhaus and in further view of United States Patent No. 6,345,436 to Codrington (hereinafter referred to as “Codrington”).

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *MPEP* §2142. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *MPEP* §2142.

Applicants respectfully point to the final prong of the test, which states the prior art must teach all the claim limitations. At the very least, the combined references do not teach all of the aspects of the independent claims.

Applicants note that at the least, the references do not teach the aspect of positioning of the shaft between the tool and the fastener. Furthermore, none of the references teach the aspect of the angle indicator located apart from the tool. As noted, the references cited by the Examiner, especially Neuhaus, Tambini and Codrington all require separate distinct tools to achieve their task. These tools tend to be very large and cumbersome and unavailable for use in small or tight spaces. Further, the present invention does not require the addition of a separate

tool to perform a single function. The present invention is incorporated with a mechanic's everyday tool set. Applicants respectfully request withdrawal of claims, 1-24.

## CONCLUSION

In view of the foregoing remarks, Applicants respectfully request withdrawal of the objections and rejections made in the outstanding Office Action. If, for any reason, the Examiner disagrees, please call the undersigned attorney at 202-861-1703 in an effort to resolve any matter still outstanding before issuing another action. The undersigned attorney is confident that any issue which might remain can readily be worked out by telephone.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036, with reference to our docket number 87355.3000.

Respectfully submitted,

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